

## **REMARKS**

This is a full and timely response to the outstanding final Office Action mailed January 14, 2005. Upon entry of the amendments in this response, claims 1 – 6 and 8 - 20 remain pending. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### **Claim Objections**

Applicants acknowledge that the claim objections presented in the previous Office Action have been removed.

### **Rejections Under 35 U.S.C. §102**

Applicants acknowledge that the claim rejections under 35 U.S.C. §102 presented in the previous Office Action have been removed.

### **Rejections Under 35 U.S.C. §103**

The Office Action indicates that claims 1 – 3, 5 – 8, 10 – 12, 14 – 17 and 19 - 20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Google* and further in view of *Nielsen*. Additionally, the Office Action indicates that claims 4, 13 and 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Google* in view of *Nielsen* and further in view of *Lawrence*. The Office Action further indicates that claim 9 stands rejected under 35 U.S.C. 103(a) as being unpatentable over *Google*. Applicants respectfully traverse the rejections.

In this regard, Applicants submit herewith a Declaration under 37 C.F.R. 1.131 that indicates the inapplicability of the *Google* reference for rejecting the pending claims. Specifically, the Declaration indicates that the invention was conceived prior to the effective

date of the *Google* reference, and that Applicants exercised diligence through the filing date of the pending application. Notably, Applicants' filing date is June 15, 2001 and the effective date of the *Google* reference is May 23, 2001. Therefore, Applicants respectfully request that the *Google* reference be removed.

Since the remaining cited references, either individually or in combination, do not teach or reasonably suggest the features/limitations recited in the pending claims, as described in detail below, Applicants respectfully assert that all pending claims are in condition for allowance.

In this regard, claim 1 recites:

1. ***A computer-implemented method for checking the spelling of words in a document during performance of an automated spell check of the document, comprising:***
  - identifying an unfamiliar word in the document;***
  - generating at least one alternative spelling of the unfamiliar word to create a word variant;***
  - providing the unfamiliar word and the at least one word variant to a search engine configured to search for a frequency of use of the unfamiliar word and the at least one word variant; and***
  - presenting information corresponding to the frequency of use of the unfamiliar word and the at least one word variant to the user.***

(Emphasis Added).

Applicants respectfully assert that the cited art does not teach or reasonably suggest at least the features/limitations emphasized above in claim 1. Therefore, Applicants respectfully assert that claim 1 is in condition for allowance.

Since claims 2 – 6 and 8 – 10 are dependent claims that incorporate all the features/limitations of claim 1, Applicants respectfully assert that these claims also are in condition for allowance. Additionally, these claims recite other features/limitations that can serve as an independent basis for patentability.

With respect to claim 11, that claim recites:

11. A system for checking the spelling of words, comprising:  
*means for identifying an unfamiliar word in a document during performance of an automated spell check of the document;*  
*means for generating at least one alternative spelling of the unfamiliar word to create a word variant;*  
means for providing the unfamiliar word and the at least one word variant to a search engine configured to search for a frequency of use of the unfamiliar word and the at least one word variant; and  
*means for presenting information corresponding to the frequency of use of the unfamiliar word and the at least one word variant to the user.*  
(Emphasis Added).

Applicants respectfully assert that the cited art does not teach or reasonably suggest at least the features/limitations emphasized above in claim 11. Therefore, Applicants respectfully assert that claim 11 is in condition for allowance.

Since claims 12 – 15 are dependent claims that incorporate all the features/limitations of claim 11, Applicants respectfully assert that these claims also are in condition for allowance. Additionally, these claims recite other features/limitations that can serve as an independent basis for patentability.

With respect to claim 16, that claim recites:

16. A computer readable medium including a program for checking the spelling of words, comprising:  
*logic configured to identify an unfamiliar word in a document during performance of an automated spell check of the document;*  
*logic configured to generate at least one alternative spelling of the unfamiliar word to create a word variant;*  
logic configured to provide the unfamiliar word and the at least one word variant to a search engine configured to search for a frequency of use of the unfamiliar word and the at least one word variant; and  
*logic configured to present information corresponding to the frequency of use of the word and the at least one word variant to the user.*  
(Emphasis Added).

Applicants respectfully assert that the cited art does not teach or reasonably suggest at least the features/limitations emphasized above in claim 16. Therefore, Applicants respectfully assert that claim 16 is in condition for allowance.

Since claims 17 – 20 are dependent claims that incorporate all the features/limitations of claim 16, Applicants respectfully assert that these claims also are in condition for allowance. Additionally, these claims recite other features/limitations that can serve as an independent basis for patentability.

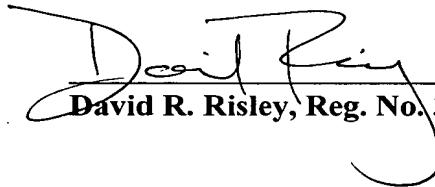
**Cited Art Made of Record**

The cited art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

## CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

  
David R. Risley, Reg. No. 39,345

**THOMAS, KAYDEN,  
HORSTEMEYER & RISLEY, L.L.P.**  
Suite 1750  
100 Galleria Parkway N.W.  
Atlanta, Georgia 30339  
(770) 933-9500

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on 4/5/04.

  
Signature

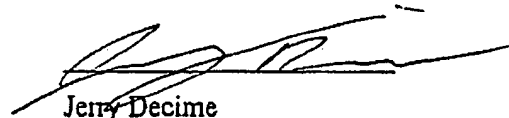


DECLARATION UNDER C.F.R. §1.131

1. We, Jerry Decime and Marc Nilson, employees of the Hewlett-Packard Company, are the inventors of the subject matter disclosed in U.S. Patent Application 09/882,940 (the "'940 application").
2. We conceived the subject matter of the '940 application at least as early as October 24, 2000, on which date we filled out an invention disclosure form of the Hewlett-Packard Company, a copy of which is attached hereto as Exhibit A.
3. Upon information and belief, the invention disclosure form that described the subject matter of the '940 application was provided to the Hewlett-Packard legal department for the purpose of determining whether a patent application should be pursued.
4. Upon information and belief, the Hewlett-Packard legal department regularly and periodically reviews invention disclosure forms that are submitted for the purpose of determining whether patent applications should be prepared and filed.
5. Upon information and belief, it was determined that a patent application should be prepared and filed based upon our invention disclosure and that the invention disclosure was referred to outside counsel for preparation of a patent application.
6. Upon information and belief, Paul Qualey, Esquire of the law firm of Thomas, Kayden, Horstemeyer & Risley was sent a copy of the invention disclosure and was requested to prepare a U.S. patent application based upon the subject matter included therein.
7. David Risley, Esquire of Thomas, Kayden, Horstemeyer & Risley corresponded with me, Jerry Decime, and began preparation of a draft application for my review.

8. Upon information and belief, the final draft of the application, which we reviewed and approved, was sent to the Hewlett-Packard legal department for review.
9. Upon information and belief, the Hewlett-Packard Company filed the patent application that is now identified as the '940 application was filed with the U.S.P.T.O. on June 15, 2001.

I hereby declare: (a) that all statements made herein of my own knowledge are true; (b) that all statements made on information and belief are believed to be true; (c) that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code; and (d) that such willful false statements may jeopardize the validity of the application or any patent issued thereon.



Jerry Decime

Date: 3-10-2005



Marc Nilson

Date: 3-10-2005

INVENTION DISCLOSURE		PAGE ONE OF _____	
PDNO	10008055	DATE RCVD	Oct 24 2000
		ATTORNEY	RCM
<p><b>Instructions:</b> The information contained in this document is COMPANY CONFIDENTIAL and may not be disclosed to others without prior authorization. Submit this disclosure to the HP Legal Department as soon as possible. No patent protection is possible until a patent application is authorized, prepared, and submitted to the Government.</p>			
<p><b>Descriptive Title of Invention:</b> <u>The Internet Search Spell Checker</u></p>			
<p><b>Name of Project:-</b></p>			
<p><b>Product Name or Number:</b></p>			
<p><b>Was a description of the invention published, or are you planning to publish? If so, the date(s) and publication(s):</b></p>			
<p><b>Was a product including the invention announced, offered for sale, sold, or is such activity proposed? If so, the date(s) and location(s):</b></p>			
<p><b>Was the invention disclosed to anyone outside of HP, or will such disclosure occur? If so, the date(s) and name(s):</b></p>			
<p><i>If any of the above situations will occur within 3 months, call your IP attorney or the Legal Department now at 1-898-4919 or 970-898-4919.</i></p>			
<p><b>Was the invention described in a lab book or other record? If so, please identify (lab book #, etc.)</b></p>			
<p><b>Was the invention built or tested? If so, the date:</b></p>			
<p><b>Was this invention made under a government contract? If so, the agency and contract number:</b></p>			
<p><b>Description of Invention:</b> Please preserve all records of the invention and attach additional pages for the following. Each additional page should be signed and dated by the inventor(s) and witness(es).</p>			
<p>A. Description of the construction and operation of the invention (include appropriate schematic, block, &amp; timing diagrams; drawings; samples; graphs; flowcharts; computer listings; test results; etc.)</p>			
<p>B. Advantages of the invention over what has been done before.</p>			
<p>C. Problems solved by the invention.</p>			
<p>D. Prior solutions and their disadvantages (if available, attach copies of product literature, technical articles, patents, etc.).</p>			
<p><b>Signature of Inventor(s):</b> Pursuant to my (our) employment agreement, I (we) submit this disclosure on this date: { _____ }.</p>			
Employee No.	Name	Signature	Entity & Lab Name
	<u>Jerry Decine</u>	<u>[Signature]</u>	<u>CES</u>
Employee No.	Name	Signature	Entity & Lab Name
	<u>Mark Wilson</u>	<u>[Signature]</u>	<u>CES</u>
Employee No.	Name	Signature	Entity & Lab Name
Employee No.	Name	Signature	Entity & Lab Name
Employee No.	Name	Signature	Entity & Lab Name

(If more than four inventors, include additional information on another copy of this form and attach to this document)

Write in dark ink on front side only please?

<b>INVENTION DISCLOSURE</b>		<b>COMPANY CONFIDENTIAL</b>	<b>PAGE</b> _____ <b>OF</b> _____
Signature of Witness(es): <i>(Please try to obtain the signature of the person(s) to whom invention was first disclosed.)</i>			
The invention was first explained to, and understood by, me (us) on this date: [ _____ ]			
Full Name	Signature	Date of Signature	
Full Name	Signature	Date of Signature	

<b>Inventor &amp; Home Address Information:</b> <i>(If more than four inventors, include addl. information on a copy of this form &amp; attach to this document)</i>				
Inventor's Full Name <i>Jerry Decime</i>				
Street _____				
City _____		State _____		Zip _____
Do you have a Residential P.O. Address? P.O. BOX _____		City _____		State _____
Zip _____		Citizenship <i>US</i>		

Inventor's Full Name Marc Nilson	
Street	
City	State Zip
Do you have a Residential P.O. Address? P.O. Box City State Zip	
Greeted as (nickname, middle name, etc)	Citizenship

Inventor's Full Name			
Street			
City		State	Zip
Do you have a Residential P.O. Address? P.O. BOX		City	State Zip
Greeted as (nickname, middle name, etc.)		Citizenship	

Investor's Full Name			
Street			
City		State	Zip
Do you have a Residential P.O. Address? P.O. BOX		City	State Zip
Greeted as (nickname, middle name, etc.)		Citizenship	

Write in dark ink on front side only please?

Description of Invention: Please preserve all records of the invention and attach additional pages for the following. Each additional page should be signed and dated by the inventor(s) and witness(es).

A. Description of the construction and operation of the invention (include appropriate schematic, block, & timing diagrams; drawings; samples; graphs; flowcharts; computer listings; test results; etc.) All spell checkers are limited by the physical dictionary on the hard-disk to overcome this, some applications make a connection to a central dictionary service on the Internet. While this does ensure that most words are found, it still doesn't catch "new" words, complex word combinations, etc. To overcome this, the system described here, after not finding a word in an offline or online dictionary will post the unfound word and several derivations of the word to an Internet search engine. It will then recommend the most likely spelling based on the number of search results.

B. Advantages of the invention over what has been done before. This process for checking a word based on its "Internet Popularity" allows a spell checker to have a "recommendation" for almost any word that could exist, including foreign language words. It relies on a dictionary that is theoretically unlimited in terms of the number and combinations of words possible. In short, this is a universal dictionary.

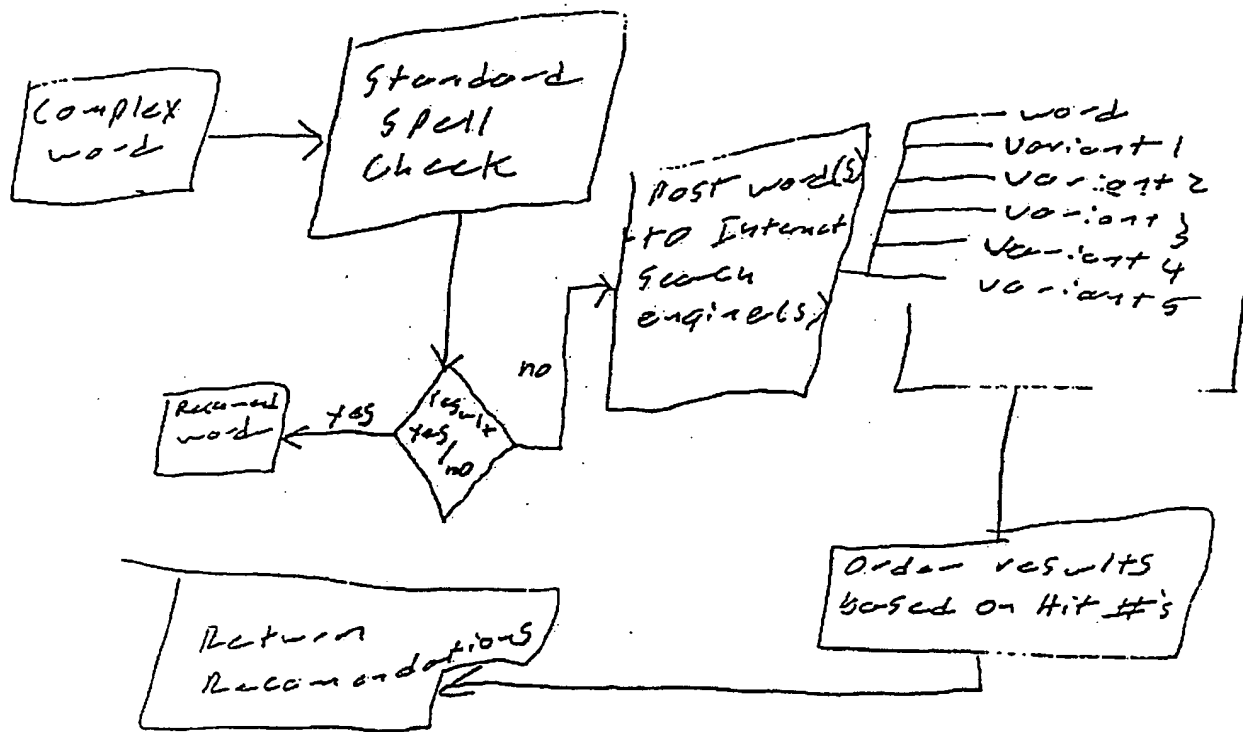
C. Problems solved by the invention

A spelling recommendation engine, web based, local, etc., will never return "no results" or a no recommendation for the spelling of a word. As new words enter a language, there is no need to update a dictionary.

D. Prior solutions and their disadvantages (if available, attach copies of product literature, technical articles, patents, etc.).

All existing spell check applications and services rely on a dictionary which is only as good as its limited maintenance. The Internet is maintained by millions of people and thus contains billions of words.

Write in dark ink on front side only please?



Example:

Outsourcer → not in dictionary → Post to search

